

REMARKS

Upon entry of this Amendment, claims 1-33 would remain pending and under current examination.

I. Regarding the Final Office Action

In the most recent Office Action, the Examiner withdrew previous rejection of claims 4, 8, and 14 under 35 U.S.C § 112 (Office Action at p. 2). The Examiner also withdrew previous rejection of claims 28, 29, and 30, under 35 U.S.C. § 101 (Office Action at p. 2). Applicants thank the Examiner for the withdrawal of these rejections.

In the most recent Office Action, the Examiner rejected claims 1-10 and 16-33 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,167,383 to Henson ("*Henson*") in view of U.S. Patent No. 5,848,399 to Burke ("*Burke*"). The Examiner also rejected claims 11-15 under 35 U.S.C. § 103(a) as unpatentable over *Henson* in view of *Burke*, and in further view of U.S. Patent No. 5,774,870 to Storey ("*Storey*")¹.

Applicants respectfully submit the Examiner has failed to establish a *prima facie* case of obviousness. Applicants address the Examiner's rejections in turn.

II. Regarding the Amendment

Applicants amend the specification to correct minor errors.

Applicants amend independent claims 1 and 24-33 to more particularly define the invention by reciting a system using "coupon information" and purchasing by a user "at a store."

Claims 2, 5, 7, 21, and 23 are amended similarly to reflect a system using "coupon information."

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

Claim 6 is amended to improve form or grammar and not for reasons related to patentability.

Claim 9 is amended to recite a system for purchasing at a “store” and to depend on claim 6.

Claims 11, 14, 16, and 18, are amended to depend on claim 6.

Applicants submit this amendment contains no new matter. Support for this amendment can be found at, for example, pp. 14-29 of the specification and in Figs. 2, 3, and 8-10.

III. Regarding the rejection of claims 1-10 and 16-33 under 35 U.S.C. § 103(a) as being unpatentable over *Henson* in view of *Burke*

Applicants respectfully submit that a *prima facie* case of obviousness has not been established with respect to claims 1-10 and 16-23.

“To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).” M.P.E.P. § 2142, 8th Ed., Rev. 2 (May 2004), p. 2100-128.

A *prima facie* case of obviousness has not been established because, among other things, neither *Henson* nor *Burke*, taken alone or in combination, teaches or suggests each and every element of Applicants’ claims.

With respect to independent claim 1, neither *Henson* nor *Burke* teaches or suggests, for example, “an information distribution apparatus including: a first purchase information memory configured to store coupon information usable by a user to purchase a commodity or utilize a service at a store; ...” as recited in claim 1 (emphasis added). *Henson* teaches “for checkout, an

at home buyer will not have to discern or be subjected to any business lease information or input” (*Henson*, col. 12, lines 30-33). *Burke* teaches “computer system for allowing a consumer to purchase packaged goods at home” (*Burke*, title). Thus, neither *Henson* nor *Burke* teaches or suggests a system providing use of “coupon information usable by a user to purchase a commodity or utilize a service at a store” as recited in claim 1 (emphasis added).

Furthermore, the Examiner concedes that neither *Henson* nor *Burke* teaches or suggests a wireless communication network (Office Action at p.4). The Examiner relies on Official Notice, alleging “wireless connections to various communications networks ... are old and well known” (Office Action at p. 4). However, even assuming the Examiner’s assertion regarding wireless communications networks is true, the assertion fails to make up for the deficiencies of *Henson* in view of *Burke*. That is, *Henson*, *Burke*, and the Examiner’s Official Notice, each fail to teach or suggest “coupon information usable by a user to purchase a commodity or utilize a service at a store,” as recited in claim 1 (emphasis added).

Because the cited references fail to teach or suggest each and every claim element, no *prima facie* case has been established for claim 1. Therefore, Applicants respectfully request the Examiner to withdraw the rejection under 35 U.S.C. § 103(a) and allow claim 1.

Independent claims 24-33, although of different scope, recite similar limitations to claim 1, which are also not taught by the cited references. Accordingly, no *prima facie* case of obviousness has been established for claims 24-33. Therefore, Applicants respectfully request the Examiner to withdraw the rejection under 35 U.S.C. § 103(a) and allow independent claims 24-33.

Also with respect to independent claims 1 and 24-33, even if the cited references taught all the claimed limitations (which they do not), the cited references lack the requisite motivation to combine the references in the manner suggested by the Examiner. As MPEP § 2142 states:

To reach a proper determination under 35 U.S.C. 103, the examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. ... Knowledge of applicant's disclosure must be put aside in reaching this determination The tendency to resort to "hindsight" based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and **the legal conclusion must be reached on the basis of the facts gleaned from the prior art** (emphasis added).

There is no teaching or suggestion in the cited references, and therefore no basis of fact, to modify the references as suggested by the Examiner. The Examiner asserts it would have been obvious to combine *Henson* in view of *Burke* with "known wireless technology ... in order to allow the user to purchase items from the seller at whatever location the user may be in at the time, i.e. increase mobility" (Office Action at pp. 4-5). However, both *Henson* and *Burke* are silent on "allow[ing] the user to purchase items from the seller at whatever location the user may be, i.e. increase mobility," as asserted for motivation to combine the references by the Examiner. Because the prior art lacks the requisite motivation, teachings, and suggestions asserted, the cited references do not establish a *prima facie* case of obviousness for this additional reason. Accordingly, Applicants respectfully request the Examiner to withdraw the rejection under 35 U.S.C. § 103(a) and allow independent claims 1 and 24-33.

Dependent claims 3-10 and 16-23 are allowable at least due to dependency on claim 1 and for additional distinctions recited therein. Therefore, Applicants respectfully request the Examiner to withdraw the rejection of these claims under 35 U.S.C. § 103(a) and allow claims 3-10 and 16-23.

IV. Regarding the rejection of claims 11-15 under 35 U.S.C. § 103(a) as being unpatentable over *Henson* in view of *Burke*, and in further view of *Storey*

Claims 11-15 depend from claim 1 and therefore include the limitations recited therein. As set forth above, neither *Henson* nor *Burke*, taken alone or in combination teach or suggest at least “an information distribution apparatus including: a first purchase information memory configured to store coupon information usable by a user to purchase a commodity or utilize a service at a store; ...” as recited in claim 1 (emphasis added).

Storey fails to cure the deficiencies of *Henson* and *Burke*. That is, *Storey* does not teach or suggest at least “an information distribution apparatus including: a first purchase information memory configured to store coupon information usable by a user to purchase a commodity or utilize a service at a store; ...” as recited in claim 1 (emphasis added) and required by claims 11-15. Therefore, Applicants respectfully request the Examiner to withdraw the rejection under 35 U.S.C. § 103(a) and allow claims 11-15.

V. Conclusion

Applicants respectfully request that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 1-33 in condition for allowance. Applicants submit that the proposed amendments of claims 1, 2, 5-7, 9, 11, 14, 16, 18, 21, and 23-33 do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined. Therefore, this Amendment should allow for immediate action by the Examiner.

Furthermore, Applicants respectfully point out that the final action by the Examiner presented some new arguments as to the application of the art against Applicant's invention. It is respectfully submitted that the entering of the Amendment would allow the Applicants to reply to the final rejections and place the application in condition for allowance.

Finally, Applicants submit that the entry of the amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

In view of the foregoing remarks, Applicants submit that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore request the entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

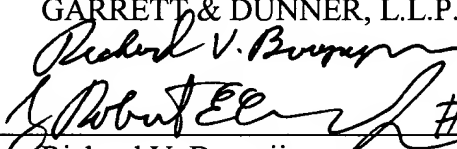
Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: April 7, 2005

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